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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,947	06/27/2003	Wilfred E. Pearce	BOEI-1-1148	3077

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EXAMINER

PECHHOLD, ALEXANDRA K

ART UNIT PAPER NUMBER

3671

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/607,947	Applicant(s) PEARCE ET AL.	
	Examiner Alexandra K. Pechhold	Art Unit 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: are the fourth and fifth members that connect the first member with the second and third members of the support member. The support member cannot function as a support member as described and illustrated without these intermediate fourth and fifth members.

Claim Objections

2. Claim 1 and 11 are objected to because of the following informalities: the applicant has added the limitation in line 3 of "a support member", but line 15 also recites "a support member" and then lines 18-19 recite "the support member". It is confusing if there is only one support member or there are two different support members, and which one is referred to in the last two lines of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Baerveldt (US 5,338,130).

Regarding claim 1, Baerveldt discloses an expansion joint comprising:

- a support member including:
 - a first generally planar member (seen as the upper planar surface of sealing strip S in Fig. 1) having an upper face which is capable of slidably supporting a bottom face of a traffic bearing surface of at least one section of a structure receivable thereon, and
 - second and third generally planar members (seen as retaining elements 2 in Fig. 1) each having an upper face capable receiving a bottom face of a portion of a bottom surface of the at least one section of the structure receivable thereon and capable of being attached thereto, the second and third members being vertically spaced-apart from and below the first member (see Fig. 1 where the top surface of S is above elements 2), and
- an expansion device interposed between the second and third members (seen as the rest of the sealing strip S), including:
 - a central portion (seen as the bottom portion of the central part of S in Fig. 1) that is capable of being attached to a support member that supports the

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bottom face of the bottom surface of the at least one section of the structure thereon; and

- end portions (seen as the parts of the sealing strip S that extend laterally above the slabs) each having an upper face that receives a bottom face of the second and third members thereon (as seen in Fig. 1 where the upper face of part of the laterally extending surfaces of S lie directly below the retaining elements 2) and a bottom face that is capable of being received on an upper face of the support member.

Regarding claim 2, the center of the strip (S) has a slit extending downward along its length, which can be viewed as a hole, and it is certainly capable of receiving a fastener therein.

Regarding claim 3, Fig. 1 illustrates adjacent sections of the structure, seen as (1) and (2).

Regarding claim 4, the retaining elements (2) shown in Fig. 1 each define a hole for receiving a fastener therein.

Regarding claim 5, the at least one section, seen as (1) in Fig. 1, is capable of allowing sliding of an overlapping portion of a second section thereon.

Regarding claims 6 and 7, composite materials are disclosed in column 2, lines 44-48, with some materials (such as thermoplastic elastomer) having equivalent expansion characteristics.

Regarding claim 8, bridge and bridge decks are disclosed in column 1, lines 7-11.

Regarding claim 9, the flexible seal strip (S) can be viewed as an expansion spring, which has a hole, seen in Fig. 1 as the longitudinal valley in the center extending downwards from the top, or the two channel-like holes extending through the interior.

Regarding claim 10, a stiffening member can be viewed as deflector elements (3) in Fig. 1.

Regarding claim 11, Baerveldt discloses the limitations of the claimed invention as discussed in regards to claim 1 and 9 above. The central portion (seen as the bottom portion of the central part of S in Fig. 1) defines a hole (seen as the two chambers formed above the surface) that is capable of receiving a fastener therein that is capable of attaching the expansion spring to a support member that supports the bottom face of the bottom surface of the adjacent sections of the structure thereon. With respect to the recitation "for attaching the expansion spring to a support member that supports the adjacent sections of the structure thereon", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 12 and 13, composite materials are disclosed in column 2, lines 44-48, with some materials (such as thermoplastic elastomer) having equivalent expansion characteristics.

Regarding claim 14, bridge and bridge decks are disclosed in column 1, lines 7-11.

Response to Arguments

5. Applicant's arguments filed 11/15/05 have been fully considered but they are not persuasive. The applicant has amended independent claims 1 and 11 in an attempt to overcome the claim rejections using Baerveldt (US 5,338,130). In light of these amendments, the Examiner is not viewing the recited "first generally planar member" as the upper planar surface of sealing strip (S) in Fig. 1 of Baerveldt, therefore meeting the new limitation of the second and third members (seen as retaining elements 2) being spaced below the first member. The applicant argues that several of the limitations are not found in Baerveldt, but these are limitations of either intended use ("for....") or non-positive recitations ("configured to..."), so therefore the structural element in Baerveldt need only be capable of performing the intended function. The applicant is not positively reciting the structure in these "configured to" recitations, and therefore Baerveldt need not disclose these relationships among the elements since the applicant's "configured to" language merely requires that Baerveldt have the ability to be configured as recited.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandra Pechhold whose telephone number is (571) 272-6994. The examiner can normally be reached on Mon-Thurs. from 8:00am to 5:30pm and alternating Fridays from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (571) 272-6998. The fax phone number for this Group is (703) 872-9306.

A handwritten signature in black ink, appearing to read 'Alexandra K. Pechhold', written in a cursive style.

Alexandra K. Pechhold
Patent Examiner
Group 3600

AKP
12/1/05